

REMARKS

I. Status of the Claims

Claims 1 and 26-88 are pending in the present application; claims 87-88 have been withdrawn pursuant to the Restriction requirement mailed August 14, 2002. Claims 26, 31, 53, 75, 76 and 84-86 have been amended to more particularly describe what Applicant considers to be the invention. Support for amended claim 26 can be found on page 7 of the specification, for example. Support for amended claim 31 can be found on pages 7-8 of the specification, for example. Support for amended claim 53 can be found on pages 13-14 of the specification, for example. Support for amended claim 75 can be found on page 15 of the specification, for example. Support for amended claim 76 can be found on pages 15-16 of the specification, for example. Support for amended claim 84 can be found on page 17 of the specification, for example. Support for amended claim 85 can be found on page 18 of the specification, for example. Support for amended claim 66 can be found on page 18 of the specification, for example. Accordingly no new matter has been added by the foregoing amendments.

II. Interviews and Information Disclosure Statement

Applicant thanks the Examiner for the personal interview and for the telephonic interview indicating which claims he viewed as being improper under 35 U.S.C. § 112 second paragraph. Applicant notes that the Application No. on the Interview Summary from the personal interview should read, 09/763,084. Applicant also notes that the

telephonic Interview Summary was dated September 10, 2003 although the telephonic interview occurred on October 9, 2003.

Applicant also thanks the Examiner for signaling his consideration of document number four of the IDS.

III. Claim Interpretation

The Examiner has appropriately removed any discussion under this section heading. Final Office Action page 2. Applicant notes that MPEP 2111 is only properly used in the context of a claim rejection.

IV. Claim Rejections under 35 U.S.C. § 112, Second Paragraph

The Examiner has rejected claims 1 and 26-86 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Final Office Action pages 2-3. Applicant respectfully traverses.

A. Alleged indefiniteness of "derivative"

The Examiner has alleged that the combined phrases "protein derivatives" "and derivatives thereof" are indefinite. *Id.* at page 3. Applicant notes that the Examiner mentions claim 27, but the word "derivative" does not appear there; it is assumed the Examiner is referring to claim 26. Although Applicant respectfully traverses this rejection for at least the reasons of record, the amendment to claim 26 renders this rejection moot.

B. Alternative listings and Markush groups

The Examiner alleges that "[s]everal of the claims contain improper alternative groupings that should be corrected." *Id.* In particular, the Examiner notes that "and" is

used several times in a single group listing alternative limitations (e.g., claim 26). The Examiner has indicated that claims 26, 53, 75, 76, and 86 are allegedly indefinite. Although Applicant respectfully traverses this rejection for at least the reasons of record, the amendments to claims 26, 53, 75, 76, and 86 render this rejection moot.

Next, the Examiner suggests that “applicants insert --the group consisting of-- after chosen from.” *Id.* The portion of the MPEP cited by the Examiner merely recites suitable examples of proper claim language, and these examples are by no means exclusive. *Id.* The Examiner also asserts that “chosen from” is open language, and as such is not proper for use in an alternative listing. *Id.* at page 7, paragraph 17. Respectfully, the Examiner is improperly interpreting the phrase “chosen from.” The words of a claim must be given their “plain meaning” absent a definition in the specification. MPEP 2111.01; *In re Zletz*, 893 F.2d 319 (Fed. Cir. 1989). In addition, Applicant notes that the “chosen from” language is found in claims of issued patents, as exemplified by issued US Patents 6,589,519, 6,599,328, and 6,589,538 (copies of which are enclosed for Examiner’s convenience). For at least these reasons, Applicant respectfully requests withdrawal of this rejection.

V. Claim rejections under 35 U.S.C. § 102(b)

A. Claims 84-86 are rejected as allegedly being anticipated by Rutter et al., US 5,731,191 (“*Rutter*”). Final Office Action pages 3-4. The Examiner asserts that “Rutter et al. discloses growth mediums[sic] that are gels comprising gellan gum and polyethylene glycol (PEG) having a molecular weight of 4000.” Although Applicant

respectfully traverses this rejection for at least the reasons of record, the amendments to claims 84-86 render this rejection moot.

B. Claims 1, 26-27, 36-37, 39-40, 59, 62-64, 69-70, 73-75, 77-79 and 83-86 are rejected as allegedly being anticipated by US 5,626,853 to Bara et al. ("*Bara*"). The Examiner asserts that "*Bara et al (example 1) disclose gel blusher compositions reading on the claims. The organopolysiloxane is a fatty phase as claimed.*" *Id.* at page 4.

Applicant respectfully traverses this rejection, at least because *Bara* teaches fluid gels and not solid gels. Col. 1 lines 40-42; See Col. 3 lines 41-51. The independent claims all recite "solid aqueous gel." Thus, since *Bara* does not teach solid gels, *Bara* does not meet each of the limitations of our claims and thus does not anticipate the claims. For at least these reasons, and for the reasons of record, Applicant respectfully requests that this rejection be withdrawn.

VI. Claim rejection under 35 U.S.C. § 103(a)

Claims 1 and 26-86 are rejected as allegedly being obvious over EP 0 803 245 A to Intercos Italia SpA ("EP '245") in view of U.S. Patent No. 5,997,887 to Ha et al. ("*Ha*"), *Bara*, and WO 97/17055, as evidenced by U.S. Patent No. 6,180,122, to Roulier et al. ("*Roulier*"), for the reasons set forth on pages 5-7 of the Final Office Action.

Applicant respectfully traverses this rejection, at least because the Examiner neglected to identify the requisite motivation to combine the cited references. In order to establish a *prima facie* case of obviousness, the Examiner must show that there is some suggestion or motivation, either in the references themselves or in the knowledge

generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. See M.P.E.P. § 2143. The Examiner has failed to do so here.

EP '245 fails to teach or suggest the present claims at least because, as admitted by the Examiner, the presently recited PEG is not disclosed. Further, the Examiner has still not presented any line of reasoning as to why one of ordinary skill in the art would choose gellan gum from the laundry list provided in EP '245. Thus, absent any source of motivation in the references themselves, the Examiner is not permitted to pick and choose elements to arrive at the claimed invention (*Ex parte Clapp*, 227 USPQ 972 (Bd. Pat. App. & Inter. 1985); *In re Wesslau*, 147 USPQ 391 (Bd. Pat. App. & Inter. 1965)); further, the Examiner still appears to be relying upon an "obvious to try" standard, which is equally impermissible (*In re O'Farrell*, 853 F.2d 894, 903 (Fed. Cir. 1988); MPEP 2145 X.B.).

In Response to Arguments, the Examiner allegedly addresses these arguments Final Office Action page 8 paragraph 20. However, he only makes conclusory statements which do not address the merits of Applicant's arguments. None of the Examiner's statements are substantiated by facts of the references or the application, or patent law. In short, the Examiner's arguments fall far short of addressing the issues Applicant's raised and thus a *prima facie* case has yet to be made.

Ha fails to remedy the deficiencies of EP '245 for several reasons. The Examiner alleges that *Ha* is combinable with EP '245 and that *Ha*'s disclosure of a range of PEG as conditioning materials shows that "the PEG compound of varied molecular weights" are "functional equivalents . . . conventional in the cosmetic art." First, note that *Ha*

does not disclose gellan and does not disclose the presently claimed PEG. Thus, no limitations in the present claims are explicitly recited in *Ha*. Second, the Examiner's statement of the functional equivalence of PEG demonstrates that the Examiner might not appreciate a feature of the present invention; Applicant has discovered that a range of PEG molecular weights gives rise to a highly desirable, unique cosmetic gel product. Thus, and contrary to the Examiner's assertion, PEG molecular weights outside this range are not functionally equivalent. Furthermore, the PEG in the two references are not functionally equivalent because PEG in EP '245 is used as a humectant (see EP '245 Col. 1 lines 40-44) whereas *Ha* teaches PEG as conditioners (see *Ha* Col. 28 line 59 through Col. 29 line 10). Since the PEG is used for different purposes in EP '245 and in *Ha*, it is improper for the Examiner to combine these references under the rationale that equivalents that are known for the same purpose may be substituted. Since the Examiner has provided no such motivation, this rejection should fall for at least this reason. Accordingly, Applicant respectfully requests withdrawal of this rejection for at least this reason, and for the reasons of record.

Also, the Examiner contends that EP '245 and *Ha* are combinable because they teach cosmetic compositions. Yet, the sole purpose of EP '245 is to provide solid gels (Abstract; Col. 1 lines 14-20) which is contrary to *Ha*, whose compositions are not solid gels (Abstract; Col. 3 lines 9-14; Col. 14 lines 51-57; Col. 34 line 14 to Col. 35 line 32; Col. 39 lines 30-35). Indeed, even *Ha*'s carriers are preferably substantially liquid. Col. 5 lines 39-41. Given the clear divergent purposes of EP '245 and *Ha*, one of ordinary skill in the art would have lacked the requisite motivation to combine their teachings. Thus, neither the Examiner's statement to combine EP '245 and *Ha*, based merely upon

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

the fact that they relate to cosmetic compositions, nor the references themselves, provide the clear and particular suggestion to combine as required by the Federal Circuit.

Bara fails to remedy the deficiencies of EP '245 and *Ha*. The Examiner alleges that PEG-12 (which has a nominal molecular weight of ~600, and is referred to as PEG 600 in *Bara*) is used with other gelling agents to form solid gels, and that gellan is disclosed as a gelling agent for the solid gels. However, this reference does not remedy the deficiencies of EP '245 and *Ha* for at least the following reasons. First, gellan is only mentioned once in the entire specification, and it is in a list of at least 17 other gelling agents. Col. 3 line 64 to Col. 4 line 5. Again, the pick-and-choose and obvious-to-try rationales do not meet the *prima facie* standard in an obviousness rejection. Second, PEG 600 is the only instantly claimed PEG that is mentioned (Example 1), and generic PEG is mentioned in a list of other hydrophilic polymers, with acrylic derivatives (like Carbopol 954) being preferred (Col. 4 lines 8-14; Examples 1-3). Thus, in addition to the pick-and-choose and obvious-to-try arguments regarding a combination which includes *Bara*'s PEGs, *Bara* teaches away from using PEG because *Bara* is directed primarily to acrylic derivatives. Therefore, *Bara* may not be combined with other references because *Bara* itself teaches away from their combination. MPEP 2143 X.D.2; *In re Grasselli*, 713 F.2d 731 (Fed. Cir. 1983). Finally, *Bara* also does not teach solids. Column 1 lines 40-42; column 3 lines 40-53. Thus, again, because EP '245 has the sole purpose of teaching solid gels whereas *Bara* only teaches non-solid gels, there is no motivation to combine the two references and there would certainly be no reasonable expectation of success in creating a solid gel if the two were combined.

In response to Applicant's teaching away argument (Final Office Action page 8 paragraph 21), the Examiner replies (a) that Applicant has presented no evidence of unobviousness and (b) that the claims are generic to "acrylate gelling agents." Applicant respectfully traverses these statements, at least because the Examiner's position here is procedurally improper. First, the burden is on the Examiner to present a *prima facie* case of obviousness, not on Applicant to present evidence of unobviousness; the Examiner has not established a *prima facie* case of obviousness. Second, at this time in the examination, it is irrelevant that acrylic derivatives are generic to the claims because, as the Examiner knows, Applicant elected the species of gellan gum. Here, again, it does not appear that the Examiner has addressed Applicant's arguments on this point.

For the aforementioned reasons, and for those of record, Applicant respectfully requests withdrawal of this obviousness rejection.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER ^{LLP}

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

In view of the foregoing remarks, Applicant submits that the present claims are neither anticipated nor obvious in view of the art of record. Applicant therefore requests the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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By: 

Harry J. Guttman
Reg. No. 51,762

Attachments:

- U.S. Patent Nos. 6,589,519, 6,599,328 and 6,589,538

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com